No. 12323

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

EARL A. ERNST,

Appellant,

vs.

A. G. CLEMENS, and, H. G. McBRIDE, and A. G. CLEMENS, and H. G. McBRIDE, doing business as IDEAL MANUFACTURING COMPANY,

Appellee.

APPELLANT'S OPENING BRIEF.

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APPELLANT'S OPENING BRIEF.

Jurisdiction.

This is a Federal suit in equity for infringement of two United States Letters Patent for two inventions, respectively, and the jurisdiction of the District Court is alleged in Paragraph III of the Complaint [Tr. p. 3] as follows:

> "The jurisdiction of the Court depends upon the patent statutes of the United States of America, and more particularly upon Section 24 of the Judicial Code. Par. 7, and R. S. Sec. 4921 (U. S. C. Title 35, Sec. 70)."

The jurisdiction of the District Court is admitted in Paragraph III of the First Amended Answer to Complaint [Tr. p. 5] as follows:

> "Defendants admit the averments of Paragraph III of the Complaint."

The jurisdiction of the District Court is also established by conclusion of law [Tr. p. 31].

This Honorable Court of Appeals has jurisdiction to review the final judgment of the District Court on appeal, according to Section 128(a) of the Judicial Code as amended (43 Stat. L. 936, 28 U. S. C. A. Sec. 225), and the Act of March 3, 1911, 36 Stat. 1091 (Judicial Code, Sec. 129 (U. S. C. Title 28, Sec. 227a)).

Statement of the Case.

Preliminary.

This is a suit in equity for infringement of United States Letters Patent No. 2,288,159, issued in the name of Fredrick J. Ernst to plaintiff-appellant, Earl Ernst, Administrator of said Fredrick J. Ernst, on June 30, 1942, for an invention in a Sacking Device, Plaintiff's Exhibit No. 1 [Tr. p. 46] and for infringement of United States Letters Patent No. Re. 22,740, issued to the plaintiff-appellant, herein, Earl A. Ernst, on April 2, 1946, for an invention in a Sack Jigger, Plaintiff's Exhibit No. 2 [Tr. p. 46], which two inventions, covered by said letters patent, being combined in one machine, have been and are now being used extensively in the United States and in Canada [Tr. p. 55] for, delivering potatoes into sacks and for "jiggling" said sacks and thereby settling and packing the potatoes in said sacks. Said Letters Patent No. Re. 22,740, Plaintiff's Exhibit No. 2 is a reissue of appellant's United States Letters Patent No. 2,347,474, issued April 25, 1944, for an invention in a Sack Jigger, Plaintiff's Exhibit No. 2-A [Tr. p. 47].

The Inventions in Suit.

Before the advent of appellant's inventions in suit, the sacking of potatoes, or packing potatoes in sacks for the market, was done almost entirely by hand. Appellant started in the business of farming potatoes as a boy of thirteen years on small potato farms in Yakima, Washington, where he first saw potatoes sacked in the year 1913, by hand, on a little stationary table. In 1920 a conveyor belt table was made for sacking the potatoes, which device was powered by a hand crank, but said device was obviously slow in operation and not a capacity potato sacking machine [Tr. p. 52]. In 1939 appellant came to Bakersfield, California, which is the center of one of the largest potato farming areas in the world, and found a slow and small capacity potato sacking machine in use in that farming area, a photograph of which machine is found in Plaintiff's Exhibit No. 7. This machine had a belt conveyor, from one end of which potatoes were delivered into one of two empty sacks supported on a shiftable platform, and when said sack was filled with potatoes, said platform was shifted, by hand, to shift said filled sack out of its filling position and to shift the remaining empty sack on the platform into its filling position to be filled with potatoes delivered thereto from said delivery end of said belt conveyor. The filled sack was then removed from said platform, while said remaining second sack was being filled with potatoes, and a third empty sack was then placed on the platform in the position from which said first filled sack was removed. When the second sack was filled with potatoes, it was removed from the platform and said platform was shifted in a reverse direction back to its said first position to bring said third sack on the platform into position to be filled with potatoes from the belt conveyor

as the first sack was filled. The above described cycle of operations was then repeated to fill as many sacks of potatoes as desired. The filled sacks removed from the platform had to be shaken or "jiggered" by hand to settle and pack the potatoes in the sacks, and, as the potatoes settled down in the sacks, more potatoes had to be put into the top of said sacks to fill the same completely. It will be noted that this slow and small-capacity potato-sacking machine, Plaintiff's Exhibit No. 7, had *no jigger board* below and alongside *one side* of the belt conveyor, *nor any baffle plate* or shearer *movable longitudinally* over the belt conveyor, as included and patented in the F. J. Ernst patent in suit No. 2,288,159, to *deflect* the potatoes over the *side edge* of the conveyor belt, successively into the manifold empty sacks supported on the jiggerboard below said conveyor as included and patented in the E. A. Ernst patent in suit, No. Re. 22,740. Said slow and small capacity machine, Plaintiff's Exhibit No. 7, was the fastest and largest capacity machine in the potato-sacking industry, and the only potato-sacking machine known in the art, as taught by all of the thirty-four prior patents set up in the defendants'-appellee's answer, when the Ernst brothers came to Bakersfield, California, in 1939 [Tr. p. 53]. Said potato-sacking machine, Plaintiff's Exhibit No. 7, being only a small capacity machine and very slow in operation, was entirely inadequate to meet the demands of the potato farmers in the Bakersfield area, who wanted to get a higher capacity of sacked potatoes, equal to at least fifteen (15) railroad freight cars a day, when they were getting only around ten (10) cars a day. The best that said machine, Plaintiff's Exhibit No. 7, could do in sacking potatoes was 150 sacks an hour by one man working like the dickens [Tr. p. 87]. Said machine, incidentally, is still being used

today, but only by small potato farmers, or people who want to run around 100 to 150 sacks of potatoes an hour. It has no utility as a large capacity machine [Tr. pp. 53, 87 and 90].

When appellant surveyed the potato sacking situation in the Bakersfield area, showing the crying need for increasing the capacity of the industry for sacking potatoes for the market, he started building a capacity sacking machine, and more particularly in developing machinery that would do the particular job of sacking potatoes for fifteen freight cars a day, to meet the demand of the potato farmers in the Bakersfield area. Appellant's experimental and development work resulted in the inventions of the patents in suit and the building of a machine embodying those inventions, as shown in Plaintiff's Exhibits 8, 9, and 10, which machine has the capacity of sacking from 500 to 600 sacks of potatoes per hour [Tr. pp. 54-55]. That machine more than met the demand of the potato farmers in the Bakersfield area for delivery of sacked potatoes for fifteen railroad freight carloads a day. There was considerable interest shown in appellant's new capacity potato sacking machine by people in the potato industry, who claimed it was one of the best items they had on the market for potatoes. Appellant first received orders for his said machine in the early 1940's and has since sold his machine continuously all over the whole country, from Idaho, Canada, Washington, Arizona, Utah, and Colorado. Appellant's machine has become generally very popular in the potato sacking industry [Tr. pp. 55 and 91].

Said Letters Patent No. 2,288,159, Plaintiff's Exhibit No. 1, were duly and legally issued to Earl Ernst, plaintiff, and appellant herein as, Administrator of the estate

of his deceased brother, Fredrick J. Ernst [Plaintiff's Exhibit No. 3, Tr. pp. 50 and 76] in whose name said Letters Patent appears, but title to said Letters Patent passed, under the laws of the State of California to Joseph A. Ernst and Mary J. Ernst, husband and wife, and surviving parents of said decedent, Fredrick J. Ernst, who never married and who died intestate. By an instrument, in writing, dated July 20, 1943 [Tr. p. 50, Plaintiff's Exhibit 4], the said Joseph A. Ernst and Mary J. Ernst assigned, transferred and set over to the plaintiff-appellant herein, Earl A. Ernst, his successors or assigns, all their right, title and interest in and to said Letters Patent No. 2,288,159, together with all their right or rights of action for any past infringement of said Letters Patent, and since said date, July 20, 1943, plaintiff-appellant has been and now is the sole owner of those Letters Patent [see Finding IV, Tr. p. 22].

Appellant's said first patent No. 2,288,159, which appears in the name of his deceased brother, Fredrick J. Ernst, Plaintiff's Exhibit No. 1, relates to a machine or device for sacking articles, such as potatoes, oranges, etc., but more particularly potatoes. The machine is adapted to receive the potatoes, or other articles, from a grader, or otherwise, and carry them along on an elongated endless belt indicated 18 or 19, and deliver the same, by means of an adjustable baffle "plate" or shearer indicated 52, from the outer edge of said belt, into open bags or sacks, indicated 12, which sacks are supported on a platform 51, and held open by holders 35, along said outer edge of said belt and below said belt, as clearly shown in the patent drawing. The baffle plate 52 extends obliquely across the belt 18 or 19 and is mounted at its ends on sleeves 54 and 55, which slide on rods 56 and 57 extending longitudinally of the

belt 18 or 19, above the belt. The "plate" or shearer 52 is manually operated and can be easily slid along the rods 56 and 57, from bag-to-bag, by applying *manual force* at the top edge of the plate, for delivering potatoes from the belt to an empty bag, after the plate 52 has delivered potatoes into and filled a preceding bag, and such intermittent movement of the plate 52 along the rods 56 and 57 from bag-to-bag is repeated until said plate has delivered potatoes into and filled all of the bags on the platform 51 along the side of the machine. A most important advantage of this machine is that the construction, arrangement and operation of the baffle plate 52 is such that when used on appellant's Sack Jigger covered by patent Re. 22,740, Plaintiff's Exhibit No. 2, it makes it possible to fill bags and sack potatoes considerably faster than any machine in the potato sacking industry [Tr. pp. 52-57]. The baffle plate or shearer indicated 52 in plaintiff's patent No. 2,288,159, Plaintiff's Exhibit No. 1, is indicated 72 in plaintiff's patent Re. 22,740.

Plaintiff's Letters Patent Re. 22,740, Plaintiff's Exhibit No. 2, is a Sack Jigger for shaking and "jiggling" sacks, indicated 34, and their contents, particularly potatoes, so as to settle the potatoes to the bottom of the sacks and compact them in said sacks. The invention embodied in said Letters Patent Re. 22,740, is shown adapted to and combined with the Sacking Device covered by Plaintiff's Letters Patent No. 2,288,159, Plaintiff's Exhibit No. 1, and said combined machine, as shown in said patent Re. 22,740, comprises generally a jigger board or *platform* indicated 22 and vibratory operating mechanism mounted in the central frame unit, indicated 1, of said machine for reciprocating, or moving said jigger board horizontally lengthwise forwardly and backwardly for jiggling the

potato sacks 34 supported upon said jigger board 22. Said jigger board is operatively suspended from the frame of the machine at its ends, and at two points intermediate its ends, by hanger means, such as straps or links 23, which links are pivotally connected at their upper ends to frame extension 24, and at their lower ends to the jigger board 22, as clearly shown in Figure 1 of the drawing of said patent Re. 22,740. The jigger board 22, as shown in said patent, is suspended by said links 23, at the front side edge of and below two endless horizontal conveyor belts 46-46, each of which belts travels over a pair of rollers 47 and 48, the rollers 48 over which said belts travel being mounted in bearings 50 (Fig. 3) close together in the central frame unit 1 of the machine, and the rollers 47, over which said belts travel being mounted in bearings 49 on the end posts of two elongated side portions or extensions 2 and 3, respectively, of the machine. The jigger board 22 is constructed with a series of cleats 28, secured to the upper side of said jigger board, across the same, in spaced relation opposite each elongated side portion or extension 2 or 3 of the machine, which spaced cleats 28 present a plurality of areas or stations upon which the bottoms of the open sacks 34 are placed to be loaded. Said cleats 28 also strengthen the jigger board and tend to reduce the likelihood of its warping. The upper open ends of the sacks 34 are hung onto a pair of spaced hooks 36, as shown in Figs. 6 and 7 of the drawing of the Re. 22,740 patent, which hooks are fixed to the inner periphery of the sack spreader loops in the frame units 37, which are mounted at their inner ends on the planks 12 at the upper edges of said planks, which are secured on the front faces of the side portions 2 and 3 of the machine. The spreader loops 44 in the frame units 37 and the hooks 36 (Figs. 6

and 7) carried by said loops are located slightly below the level of the upper reaches of the conveyor belts 46 and forwardly of the outer or front side edges of said belts, as clearly shown in Figs. 1, 2, 3, 5 and 7, of the patent drawing, so that the potatoes on said upper reaches of said conveyor belts 46 may be diverted therefrom by baffle plates or shearers 72 over said outer or front side edges of said belts into the upper open ends of the sacks 34 supported on the jigger board 22 and held open at their upper ends by the hooks 36 fixed to the inner periphery of the sack spreader loops of the frame units 37. The baffle plates or shearers 72 correspond to the baffle plate or shearer 52 of the patent in suit No. 2,288,159, Plaintiff's Exhibit 1, and said baffle plates or shearers 72 are slidably mounted above the upper reaches of the conveyor belts 46 by means of sleeves 73 and 74, slidable on rails or rods 75 and 76, respectively, to which sleeves the ends of said baffle plates 72 are secured and which rails or rods are located above the side edges respectively of the conveyor belts 46, with one end of said rails or rods secured to the upper ends of the outer-end supporting posts 8 and 9 of the side portion 2 of the machine, and the other ends of said rails or rods 75 and 76 secured to the upper ends of the outer-end supporting posts 10 and 11 of the side portion 3 of the machine.

The vibratory mechanism, mounted in the central frame unit 1 of the machine for moving the jigger board 22 lengthwise forwardly and backwardly horizontally, for jiggling said jigger board to settle and pack the potatoes in the sacks 34, comprises an electric motor 67, on the shaft of which motor is secured a small pulley wheel 68; an endless belt 69 extending over said pulley wheel 68 and over a larger pulley 66 secured on a shaft 54 journaled at its ends in bearings on the horizontal frame members 20 of

the central frame unit 1 (Figs. 1 and 2); a small sprocket 65 secured on said shaft 54, and a chain 70 (Fig. 1) extending over said sprocket 65 and over a larger sprocket 55′ secured on a shaft 53 (Figs. 1 and 2); and a crank 56 (Fig. 2) on the near end of said shaft 53 journaled in a plate 57 (Fig. 2) of a push and pull rod unit or "jigger" 58 (Fig. 1), which includes a bar 59 secured at one end to said plate 57, and pivotally connected at its outer end at 61, to the upper end of the vertical arm 62 of an angle bracket 60, the horizontal arm 63 of which bracket is bolted to the jigger board 22. The plate 57 and the bar 59 connected to said plate constitute the "pitman" referred to in claim 1 of the patent (Re. 22,740) on which claim this suit is brought.

Driving mechanism is provided for driving the conveyor belts 46 from the motor 67, which mechanism comprises a sprocket wheel 55 (Fig. 2) secured on the shaft 53 and a chain 71 extending over said sprocket 55 and over a small idler sprocket wheel 52 and sprocket wheels 51-51 secured on the shafts 48′-48′ of the inner end rollers 48-48, respectively, which shafts 48′-48′ are journaled in bearings on horizontal bar members 21 of the central frame unit 1, the idler sprocket wheel 52 also being journaled in a bearing in one of said bar members 21.

In operation, the unfilled sacks 34 are first placed upon the platform or jiggerboard 22, with the bottom of each sack resting upon said jiggerboard over a station cleat 28 and with the upper open end of each sack hung at four corners on the four hooks 36 of a frame unit 37, within the U-shaped spreader loop 44 of said frame unit, which loop is held in its adjusted spread position by set screws 45 in tubular supports 42 and 43 in which supports the loop

ends are telescopically fitted, as shown in Fig. 1 and as illustrated in Figs. 5, 6 and 7, of the patent drawing. The cleats 28 provide stations for the sacks 34 in suitably spaced relation along the platform or jiggerboard 22, and hold said sacks against slipping lengthwise on said jiggerboard and in position to receive the potatoes from the conveyor belts 46. The motor 67, being turned on, the platform or jiggerboard 22 is reciprocated or moved forwardly and backwardly lengthwise by said motor, through the medium of the motor pulley 68, belt 69, pulley 66, shaft 54, sprocket 65, chain 70, sprocket 55′, shaft 53, crank 56, jigger 58 and bracket 60, while the conveyor belts 46-46 are driven, with their upper reaches moving outwardly over their rollers 48-48 and 47-47, by said motor 67, through the medium of said parts for reciprocating said jiggerboard, sprocket 55 on shaft 53, and the chain 71 extending over said sprocket 55, the idler sprocket 52 and the belt roller sprockets 51-51. Potatoes are then delivered from a grader or otherwise, onto the inner ends of the upper reaches of the endless conveyor belts 46-46, and said potatoes are conveyed outwardly by said belts on their upper reaches until said potatoes strike against the two baffle plates or shearers 72 above the belts 46 on the side portions 2 and 3, respectively, of the machine, and said potatoes are deflected laterally and forwardly by said baffle plates from the belts 46-46 over the front side edges of said belts, at the front of the machine, and the potatoes are dropped into two open sacks 34, respectively, supported on the left and right end portions of the platform or jiggerboard 22, at the front of said side portions 2 and 3, respectively, of the machine, and the potatoes thus dropped into said sacks are "jiggled" and thereby settled and packed compactly in said sacks by the horizontal forward and

backward movement of the platform or jiggerboard 22 which movement is produced by the motor 67 and interconnected parts as aforesaid.

In the operation of the machine, the baffle plates 72 may be moved manually inwardly or outwardly on the rods 75 and 76 from one sack 34 to another, as each sack is filled with potatoes, deflected from the belts 46 by said baffle plates, and as each sack is filled with potatoes it is disconnected at its upper end from the frame unit 37 holding said end of said filled sack, and said filled sack is removed from the platform or jiggerboard 22, and another unfilled sack is positioned on said jiggerboard and hooked in said frame unit 37 at its upper end in place of said removed filled bag, without stopping the machine. The sleeves 73 and 74 to which the baffle plates 72 are secured may be made to slide freely on the rods 75 and 76 in which case the operator would hold the plate in position opposite each sack until the sack was filled with potatoes deflected by said plate, or the sleeves 73 and 74 could be made to fit the rods 75 and 76 more closely so that the potatoes striking the plate would tend to turn the plate and cause the close-fitting sleeves to bind on said rods and automatically hold the baffle plate 72 firmly in position opposite each sack until it is filled, whereupon the operator with a little manual force applied to the upper part of said baffle plates may release the binding engagement of the sleeves 73 and 74 with the rods 75 and 76 and move the sleeves 73 and 74 along the rods 75 and 76 together with said baffle plates 72 to the next sack for filling the same with potatoes.

In said Letters Patent, in suit, No. Re. 22,740, page 1 of the specification first column, in third and second lines from the bottom of the page, it is stated:

"One of the side portions may be omitted entirely."

The side portions referred to are the side portions 2 or 3 at the left and right sides, respectively, of the central frame unit 1 of the machine. If, for example, the left side portion 2 of the machine were omitted and the corresponding left end portion of the jiggerboard 22 opposite said left side portion of the machine were cut off from the remaining portion of said jiggerboard, the vibratory means, including the "pitman" formed by the plate 57 and bar 59 would be *connected by said pitman at the left end of the jiggerboard 22, as at 61,* by the bracket 60, which would, in that case, be *at said end open locus* of the jiggerboard, instead of at a central open locus corresponding to the central frame unit 1 of the machine, which locus is referred to in claim 1 of the patent. The machine with one side portion 2 or 3 omitted would leave the other side which would function the same as if the omitted side were retained, and the machine with only one side portion 2 or 3 would be what is known in the industry as *"a one-man jigger"* [Tr. pp. 59-60], as shown in Plaintiff's Exhibit 12-B.

The defendants-appellees and others controlled by them have manufactured, used and sold machines for delivering potatoes into sacks and for "jiggling" said sacks and settling and packing the potatoes in said sacks, which machines embody the inventions of the patents in suit and

infringe Claim 1 of each of said patents, said infringing machines of the defendants-appellees being shown and described in Plaintiff's Exhibits 5 and 6, Plaintiff's Interrogatories and Interrogatory Exhibits 1, 2 and 3-3, and shown in Plaintiff's Exhibits Nos. 11-A, 11-B and 11-C, Plaintiff's Exhibits Nos. 12-A and 12-B, Plaintiff's Exhibit 13 for Identification, and Defendant's Exhibits A, B, C, D and E.

The District Court has held Claim 1 of each patent in suit *valid* [Tr. pp. 17 and 31-32], but not infringed, and since defendants-appellees have not taken an appeal from the judgment of the lower court holding Claim 1 of each patent in suit valid, said judgment is *final* as to the validity of said claims, and the only question on appeal to be decided by this Honorable Court is the question of *infringement* by the appellees, of Claim 1 of each of appellant's patents in suit [Tr. pp. 17 and 31-32], the remaining claims of said patents not being sued on or involved in this litigation.

The final Judgment of the District Court [Tr. p. 33] is contrary to said court's decision [Tr. p. 17] and the Findings of Fact, XVIII and XIX and Conclusions of Law 2 and 3 [Tr. pp. 31-32], since said Judgment erroneously dismissed the whole Complaint upon the merits, and failed to adjudicate Claim 1 of each patent in suit valid in accordance with said Court's decision and Findings of Fact and Conclusions of Law, and the ruling of the Supreme Court in *Sinclair and Carroll v. Interchemical Corp.,* 89 L. Ed. 1644, 1646, 325 U. S. 326, 330.

Specification of Errors Relied Upon.

Appellant, Earl A. Ernest, presents this specification of errors relied upon and intended to be urged in the prosecution of his appeal from the Final Judgment of the District Court below, entered herein on or about March 28, 1949, and asserts that said trial court erred in each of the following respects, to-wit:

1. In holding and deciding that Claim 1 of Patent No. 2,288,159 (F. J. Ernst), issued June 30, 1942, is not infringed by the defendants.

2. In holding and deciding that Claim 1 of Reissue Patent No. Re. 22,740, reissued on April 2, 1946, is not infringed by the defendants.

3. In rendering judgment for the defendants; neither side to recover any costs.

4. In not adjudging and decreeing that Claim 1 of Patent No. 2,288,159 of Fredrick J. Ernst, issued June 30, 1942, is infringed by the defendants, and each of them.

5. In not adjudging and decreeing that Claim 1 of Reissue Patent No. 22,740, of Earl A. Ernst, reissued on April 2, 1946, is infringed by the defendants, and each of them.

6. In failing to render judgment for the plaintiff as prayed, including his costs, an injunction, and an accounting for damages against defendants, and each of them.

7. In unduly limiting Claim 1 of Letters Patent in suit, No. 2,288,159, to such narrow scope as to enable the defendants to escape infringement of said claim, and

despite the failure of the prior art to impose any such limitation upon said claim.

8. In unduly limiting Claim 1 of Reissue Letters Patent No. Re. 22,740, in suit, to such narrow scope as to enable the defendants to escape infringement of said claim, and despite the failure of the prior art to impose any such limitation upon said claim.

9. In failing to accord Claim 1 of Letters Patent No. 2,288,159, in suit, its proper and full scope beyond the prior art, to which it is fairly entitled, and in failing to hold the defendants' accused machines infringements of said claim in accordance with its true scope.

10. In failing to accord Claim 1 of Reissue Letters Patent No. Re. 22,740, in suit, its proper and full scope beyond the prior art, to which it is fairly entitled, and in failing to hold the defendants' accused machines infringements of said claim in accordance with its true scope.

11. In failing to give Claim 1 of Letters Patent No. 2,288,159, in suit, a liberal interpretation in view of the substantial advance in the art made by the invention covered by said claim, and in failing to hold the defendants' accused machines infringements of said claim as so interpreted.

12. In failing to give Claim 1 of Reissue Letters Patent No. Re. 22,740, in suit, a liberal interpretation, in view of the substantial advance made in the art by the invention covered by said claim, and in failing to hold the defendants' accused machines infringements of said claim, as so interpreted.

13. In failing to recognize the long step forward, taken by the inventions, as covered by the claims in issue

of the patents in suit, and the substantial advance in the art marked by said inventions, and in failing to apply the applicable rule of construction to said claims, which entitled said claims to a liberal construction, whereby said claims may be read to include the defendants' accused potato-sacking machines, and to establish infringement of said claims by the defendants and each of them.

14. In deciding and holding, contrary to the evidence, that Claim 1 of Patent No. 2,288,159 (F. J. Ernst), issued June 20, 1942, is not infringed by the defendants.

15. In deciding and holding, contrary to the evidence, that Claim 1 of Reissue Patent No. Re. 22,740, reissued on April 2, 1946, is not infringed by the defendants.

16. In failing to order, adjudge and decree, in the formal judgment of the court, that Claim 1 of Patent No. 2,288,159 of Fredrick J. Ernst, issued June 30, 1942, is good and valid in law, in accordance with the decision of the court, dated and filed March 12, 1949.

17. In failing to order, adjudge and decree, in the formal judgment of the court, that Claim 1 of Reissue Patent No. Re. 22,740, reissued on April 2, 1946, is good and valid in law in accordance with the decision of the court.

18. In not finding that the inventions, as defined by the claims in issue of the patents in suit, are a distinct advance in the art and rendered all other systems in the art obsolete.

19. In not finding that the defendants did not follow the prior art in their alleged noninfringing machines, but followed and adopted the systems defined by the claims in issue of the patents in suit.

20. In not holding that the patents in suit marked a distinct advance in the art over and beyond the skill of the calling.

21. In not finding that the plaintiff's method and devices as defined by the claims in issue of the patents in suit, supplanted all other systems of like nature in the potato-sacking art.

22. In that the several findings and conclusions are not in accordance with the facts or in accordance with the law of the case.

23. In holding that the inventions in suit are in a crowded art, as contrary to the evidence and contrary to law.

24. In failing to find that none of the prior patents pleaded by the defendants were ever adopted or used, and that said patents are of the paper type.

25. In finding IX as contrary to the evidence and contrary to law.

26. In finding X as contrary to the evidence and contrary to law.

27. In holding and deciding that Claim 1 of the patent in suit, No. 2,288,159, is required to be narrowly construed and thus construed is valid, but not infringed by the defendants.

28. In failing to order, adjudge and decree that Claim 1 of the patent in suit, No. 2,288,159, is entitled to a liberal interpretation commensurate with its broad scope in view of the prior art and in view of the fact that said patent marked a substantial advance in the art, and thus interpreted is good and valid in law, and is infringed by the accused devices of the defendants and each of them.

29. In holding and deciding that Claim 1 of the patent in suit, Reissue 22,740, is required to be narrowly construed and thus construed is valid, but not infringed by the defendants and each of them.

30. In failing to order, adjudge and decree that Claim 1 of the patent in suit, Reissue 22,740, is entitled to a liberal interpretation commensurate with its broad scope, in view of the prior art, and in view of the fact that said patent marked a substantial advance in the art, and thus interpreted is good and valid in law, and is infringed by the accused devices of the defendants and each of them.

31. In holding and deciding that the Complaint should be dismissed for want of equity, as to the charge of infringement by the defendants of the patents in suit.

32. In Ordering, Adjudging and Decreeing that the Complaint herein be and it is hereby dismissed upon the merits.

Issues.

1. Do the devices and machines made, used, and/or sold by the defendants-appellees infringe Claim 1 of Patent No. 2,288,159 in suit? This issue is presented by Appellant's Specification of Errors Relied Upon, Nos. 1, 4, 7, 9, 11, 13, 14, 19, 27, and 28.

2. Should Claim 1 of Patent No. 2,288,159 in suit, be narrowly construed or limited in view of the prior art, to such extent as to read out of said claim the devices and machines made, used and/or sold by defendants-appellees, which devices and machines are alleged to infringe said claim of said patent? This issue is presented to this Honorable Court by appellant's Specification of Errors

Relied Upon, Nos. 7, 9, 11, 13, 18, 19, 20, 21, 23, 24, 27, and 28.

3. Do the devices and machines made, used and/or sold by the defendants-appellees infringe Claim 1 of Patent No. Re. 22,740 in suit? This issue is presented by Appellant's Specification of Errors Relied Upon, Nos. 2, 5, 8, 10, 12, 13, 15, 19, 25, 26, 29 and 30.

4. Should Claim 1 of Patent No. Re. 22,740 in suit, be narrowly construed or limited, in view of the prior art, to such extent as to read out of said claim the devices and machines made, used and/or sold by defendants-appellees, which devices and machines are alleged to infringe said claim of said patent? This issue is presented by appellant's Specification of Errors Relied Upon, Nos. 8, 10, 12, 13, 18, 19, 20, 21, 23, 24, 25, 26, 29 and 30.

5. Are the Decision, Findings of Fact and Final Judgment of the District Court concerning the question of infringement of one or both patents in suit, contrary to the evidence? This issue is presented by Appellant's Specification of Errors Relied Upon, Nos. 1, 2, 4, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, and 30.

6. Are the Decision, Conclusions of Law and Final Judgment of the District Court contrary to law? This issue is presented by Appellant's Specification of Errors Relied Upon, Nos. 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 16, 17, 22, 23, 25, 26, 27, 28, 29, 30, 31 and 32.

ARGUMENT.

This suit for infringement being brought on two patents, said patents will be taken up in the order of their dates of issuance by the Patent Office.

First Patent No. 2,288,159.

The first Patent No. 2,288,159, issued to Fredrick J. Ernst, June 30, 1942, is for a Sacking Device or a device for unloading belt conveyors of articles, such as potatoes and the like, into sacks 12, respectively, which sacks are supported alongside of and below a side edge of conveyor belts 18 and 19 on a platform 51, in position to receive said articles unloaded from said side edge of said conveyor belts, whereby said articles are sacked for the market. The invention covered by Claim 1 of said patent, which is the only claim of said patent on which this suit is brought, relates particularly to the shiftable baffle plate or shearer indicated at 52 in the patent drawing, which plate is mounted in any suitable maner to be shifted or moved longitudinally over a belt conveyor from one of said sacks 12 to another for deflecting and unloading articles, such as potatoes or the like, from said belt conveyor over a side edge of the belt into said open sacks, respectively, which are supported adjacent to and slightly below said edge of said conveyors.

Claim 1 of appellant's said first patent, No. 2,288,159, which is the claim of said patent sued on, is as follows:

> "1. A device for unloading belt conveyors of articles, an endless belt, roller means coupled to the belt at its ends for supporting it, mechanism for

rotating the roller means, a pair of spaced bars longitudinally of the belt and substantially the length thereof, said bars being spaced above and substantially over the longitudinal edges of the belt, a loose sleeve on each bar having attached coupling means to hold a plate, a plate having a portion of its ends in the coupling means, said coupling means forming an acute angle with the sleeves so that the plate is positioned obliquely across the belt for the purposes described."

Important elements of the invention covered by said claim are an *endless belt,* indicated at 18 or 19 in the patent drawing, mechanism for rotating the belt roller means, a pair of spaced bars 56 and 57 extending longitudinally of each belt and substantially the length thereof above the edges of the belt, *loose sleeves,* 54 and 55, *or their equivalent movable along said bars,* respectively, and a plate 52 coupled or connected at its ends to said sleeves, respectively, so that said plate is positioned *obliquely* across said belt 18 or 19, against which plate the articles, such as potatoes, are brought by said belt, and said articles are deflected and shifted by said plate over a *side edge* of said belt into the sacks 12, respectively, supported on the platform 51 alongside of and below said side edge of said belt conveyor. As each sack 12 is filled with potatoes deflected by the plate 52 into a sack, said plate is moved along the rods 56 and 57 to the next sack to be filled and so on until all of the sacks are filled with potatoes. The plate 52 stays in each position to which it is moved on the rods 56 and 57 until the potatoes are deflected by said plate into each sack 12, and said plate does not have to be locked to hold it in position for deflecting the potatoes into any sack [Tr. pp. 56-57].

INFRINGEMENT OF CLAIM 1.

Patent No. 2,288,159.

Issue 1.

Infringement of Claim 1 of Patent in suit, No. 2,288,-159, by defendants-appellees, is shown clearly in Plaintiff's Interrogatories and Defendants' Answers to Plaintiff's Interrogatories including Exhibit 1, Exhibit 2, and Exhibits 3-3 of said Interrogatories, Plaintiff's Exhibits 5 and 6, Plaintiff's Exhibits No. 11-B, and Defendants' Exhibits A, B, C, D and E.

Interrogatory Exhibits 1, 2 and 3 of Plaintiff's Interrogatories, Exhibit 5, and Defendants' Answers to Plaintiff's Interrogatories II, VII, IX, and XI, Plaintiff's Exhibit 6, prove that defendants-appellees since the date of Patent in suit No. 2,288,159, June 30, 1942, have made, used and/or sold a sacking device or a device for unloading belt conveyors containing all of the elements of the combination of elements included in Claim 1 of said Patent No. 2,288,159, and consequently defendants-appellees have infringed said claim of said patent.

Defendants' Answer to Plaintiff's Interrogatory VII admits that defendants-appellees have made, used, and sold a sacking device or device for unloading belt conveyors prior to the filing of this suit as shown in Exhibit 1 of said Interrogatory, and Defendants' Answer to Plaintiff's Interrogatory IX admits that the defendants-appellees have manufactured and sold a sacking device or device for unloading belt conveyors, prior to the filing of this suit, as shown in Exhibit 2 of said Interrogatory, and as covered by Claim 1 of Patent in suit, No. 2,288,159. Defendants' Answer to Plaintiff's Interogatory XI admits that defendants-appellees have made and sold ap-

paratus as illustrated in Exhibit 3-3 of said Interrogatory. The Exhibit 3 showing a full machine on a smaller scale than the other Exhibit 3 shows the baffle plates or shearers 52 slidably mounted over the belt conveyors 18 and 19, as described and claimed in Claim 1 of the Patent in suit, No. 2,288,159.

Defendants' counsel stipulated that Plaintiff's Exhibits 11-A, 11-B and 11-C are photographs of one of the machines manufactured by the defendants. [Tr. p. 61.] Plaintiff's Exhibit 11-B shows the baffle plates for diverting potatoes from a belt conveyor over the outer side edge of the conveyor into sacks, which baffle plates are covered by Claim 1 of the Patent in suit, No. 2,288,159, and are designated 52 in said patent.

Defendants' Exhibits A, B, C, D and E, photographs of defendants' accused sacking machines, show every element or its equivalent, in the *combination* of elements contained in Claim 1 of appellees' patent in suit, No. 2,288,-159, and consequently said accused sacking machines of the defendants shown in said exhibits infringe said claim of said patent.

Defendants' Exhibits A, B and C show one and the same form of defendants' accused sacking machines, or devices for unloading belt conveyors [Tr. pp. 108 and 109].

Defendants' Exhibit D, from the only testimony concerning it given by defendants' witness, Darby Day, is evidently the same type of machine shown in Plaintiff's Exhibit 11-C and Plaintiff's Exhibit 13 [Tr. p. 112], while Defendants' Exhibit E, from the testimony of the same witness, is evidently of the type of machine shown in Defendants' Exhibits A, B and C, and in Plaintiff's Exhibit 11-B, but the testimony of said witness concern-

ing the operation of this form of defendants' machine, Defendants' Exhibit E, is not very clear. However, both of Defendants' Exhibits D and E show a baffle plate, which is movable over and along a conveyor belt to divert potatoes from said belt over its outer edge into sacks supported on a jigger board below.

The defendants have made slight modifications in the details of the construction of their baffle plate in an obviously crude and futile attempt to avoid infringement of Claim 1 of appellant's patent in suit No. 2,288,159.

Instead of the appellant's loose sleeves, indicated 54 and 55, in his said patent No. 2,288,159, the defendants-appellees have substituted what they call *trolleys* [Tr. p. 69, Plaintiff's Exhibit 11-B] comprising a carriage with wheels which roll on *two rods* as shown in Interrogatory Exhibits 1 and 2, of defendants' machine [Plaintiff's Exhibit 5 and Plaintiff's Exhibit 6, Defendants' Answer to Interogatory II]. Said *trolleys* of the defendants' machine are Form 1 of appellee's machine and are nothing more than a *change of form* and a *mechanical equivalent* of appellant's *loose sleeves,* because said trolleys of appellees' machine *perform the same function in substantially the same manner and accomplish the same result as appellant's loose sleeves,* in serving as a carriage for the baffle plate to enable said plate to be moved along rods or tracks longitudinally over the belt conveyor from one sack to another, for diverting and unloading potatoes from the conveyor over its side edge successively, into the sacks supported on the jigger board, below said edge of the conveyor. The *trolleys* [Plaintiff's Exhibit 11-B] carrying the *appellees'* baffle plate, meet the acid test of equivalency of the appellant's *loose sleeves* 54 and 55, carrying *appellant's* baffle plate, designated 52 in the specification and

drawing of appellant's patent in suit, No. 2,288,159, and included in Claim 1 of said patent.

> "There are two tests of equivalency: (a) identity of function; (b) substantial identity of way of performing that function."
>
> Walker on Patents (Deller's Ed.), Sec. 466, p. 1703.

The carriages for the baffle plate in appellees' devices or machines for unloading potatoes from the conveyor belt into sacks, as shown in one of Plaintiff's Interrogatory Exhibits 3 of Plaintiff's Exhibit 5; in Plaintiff's Exhibit 11-B; in Defendants' Exhibits A, B, C and E; and in Defendants' Exhibit D, are likewise mechanical equivalents of appellant's baffle plate carriages embodied in appellant's *loose sleeves* designated 54 and 55 in appellant's Patent No. 2,288,159.

In said Plaintiff's Interrogatory Exhibit 3 of Plaintiff's Exhibit 5, Plaintiff's Exhibit 11-B and Defendants' Exhibits A, B, C and E, instead of *two rods* being used as tracks for the baffle plate trolleys, as shown in Plaintiff's Interrogatory Exhibits 1 and 2 of Plaintiff's Exhibit 5, and as stated in Defendants' Answer to Interrogatory II, as Form 1, defendants-appellees use what they designate as Form 2 in their Answer to Plaintiff's Interrogatory II, which Answer describes said Form 2 of defendants' baffle plate carriage and tracks on which said carriage runs, as follows:

> *"Form 2.* This form is identical to Form 1, *except* that only *one overhead rod* and *trolley* association *is employed.* On the opposite side a horizontal *track* is formed as a part of a steel *plate* extending along-

side the belt as an element of the table framework upon which the rollers and associated mechanism are supported. On this *track* for rolling move*ment is a sheave and axle which connects with one end of the shear plate.*"

Said *sheave and axle* of said Form 2 of the defendants'-appellees' baffle plate carriage and tracks are best shown in Plaintiff's Exhibit 11-B and in Defendants' Exhibits A, B and C. This form of defendants'-appellees' baffle plate carriage and carriage tracks comprising a *trolley* at one end of the baffle plate running on a single *rod,* and a *sheave* at the other end of the baffle plate running on the upper edge of an elongated *plate,* is nothing more than a *change of form* from appellant's carriage comprising a pair of *loose sleeves* connected to both ends of the baffle plate and running on a *pair of rods.* Such a *change of form* of the appellees' baffle plate carriage is nothing more than a *mechanical equivalent* of appellant's baffle plate carriage and is an infringement of claim 1 of appellant's patent No. 2,288,159. A *change of form* of a patented machine does not avoid infringement of the patent. The change of form of appellees' baffle plate carriage from that of appellant's baffle plate carriage involves *no change of function, operation, or results,* and consequently involves no change sufficient to avoid infringement of appellant's patent.

"Change of *form* without change of *function* does not avoid infringement."

Triangle Kopok Mach. Corp. v. Solinger Bedding Co., 13 F. 2d 494;

Machine Co. v. Murphy, 97 U. S. 120.

"It does not necessarily follow, from the fact that a claim of a patent describes a specified *form* of construction of a machine or part, that the inventor is limited to that form; but it depends on his expressed intention and the scope of his actual invention."

Kings County Raisin & Fruit Co. v. Consol. S. R. Co., 192 Fed. 59 (C. C. A. 9th Cir.).

"The patentee having described his invention and shown its principles, and claimed it in that *form* which most perfectly embodies it, is in contemplation of law, deemed to *claim every form* in which his invention may be copied, unless he manifests an intention to disclaim some of those forms."

Western Electric Co. v. La Rue, 139 U. S. 601, 606, 11 S. Ct. 670, 35 L. Ed. 294.

"No substitution of an equivalent for an ingredient of a combination covered by any claim of a patent can avert a charge of infringement of that claim (O'Riley v. Morse, 15 How.) (56 U. S. 61, 62) (1853) (and other cases cited) whether or not the equivalent is mentioned in the patent."

Walker on Patents (Deller's Ed.), Vol. 3, Sec. 464, pp. 1700-1701.

"The *substantial equivalent of a thing* is, in the sense of the patent law, *the same as the thing itself.* Two devices which perform the same function in substantially the same way, and accomplish the same result, are, therefore, the same, though they may differ in name and form."

Machine Co. v. Murphy, 97 U. S. 120.

In Defendants' Exhibit D appears a crude imitation of appellant's baffle plate carriage, comprising a pair of

roller skates on which the baffle plate is suspended and which roller skates roll along on angle irons over a belt conveyor for the potatoes. [Tr. p. 112.] The appellees' roller skates are obviously a crude equivalent of appellant's loose sleeves, and the appellees' angle irons on which the skates run are obviously an equivalent of the two rods on which appellant's loose sleeves run. Appellees' device, Defendants' Exhibit D, is a clear infringement of Claim 1 of appellant's Patent No. 2,288,159.

Appellant, Earl A. Ernest, was cross-examined concerning the *coupling means* on the loose sleeves 54 and 55 for connecting the ends, respectively, of the *baffle plate* or shearer 52 to said sleeves, so that said plate is positioned obliquely across the belt, as included in claim 1 of the patent in suit No. 2,288,159, and the witness was asked to show the equivalent of that in the defendants' device [Tr. p. 71]. In the patent the coupling means to hold the baffle plate 52 are the small brackets on the inner side of the loose sleeves 54 and 55, in which brackets the ends respectively of the baffle plate 52 are bolted or welded [Tr. pp. 73-74]. The patentee, Ernst, did not intend to limit the baffle plate coupling means to any particular construction, since said means is not specifically described, other than on page 2 first column, lines 21 and 22, which states that the top of each shearer is welded to the spaced apart sleeves 54 and 55. The *equivalent* of the *coupling means* of the baffle plate described in Claim 1 of the patent in suit No. 2,288,159, is included in appellees' machines, as shown in Plaintiff's Interrogatory Exhibits 1 and 2, Plaintiff's Exhibit 5, and Plaintiff's Exhibit 11-B, and as described in Defendants' Answer to Plaintiff's Interrogatory II. Defendants' baffle plate coupling means is not shown in Plaintiff's Exhibit 11-A or

11-C. The baffle plate coupling means in defendants' machines is best shown in Interrogatory Exhibit 2 at the left side of the exhibit and comprises a shank bent downwardly vertically from the left end of the trolley frame, which shank is provided with a vertical slot through which extends a bolt, whereby one end of the baffle plate or shearer is bolted to said shank. In Interrogatory Exhibit 1 the depending shank from the trolley frame at the opposite side of the machine is shown with the other end of the baffle plate bolted or coupled to said shank, with said baffle plate extending obliquely across the conveyor belt as specified in Claim 1 of said patent No. 2,288,159. In Plaintiff's Exhibit 11-B the depending shank is shown at the right end of the trolley designated W with the right end of the baffle plate bolted or coupled to said depending shank of the trolley frame with the baffle plate extending obliquely across the conveyor belt. Defendants' Answer to Plaintiff's Interrogatory II describes the baffle plate coupling means of defendants' machine as follows:

> "The diversion is accomplished by a shear plate positioned diagonally across the belt. This plate is suspended from a pair of rods located above the belt somewhat shorter than the belt. A trolley comprising two pairs of sheaves mounted in a framework is arranged for rollable travel on each of the rods. From the frame work vertically depends a suspension member, the lower end of which is bolted to the shear plate. A vertical slot is provided in the suspension member so that the elevation of the shear plate may be adjusted."

There is no question that the appellees' device has the coupling means to hold the baffle plate in position obliquely across the belt, as covered by claim 1 of the patent in suit No. 2,288,159.

Defendants' counsel evidently contends that the defendant-appellees' machines do not infringe Claim 1 of the patent in suit No. 2,288,159, in view of fact that appellants' baffle plate carriage has no latch to hold the baffle plate steadily in position while diverting potatoes from the belt into any sack for filling the sack [Tr. pp. 56-57 and 71] while appellees' machines have such a latch [Tr. p. 70], as best shown in Plaintiff's Interrogatory Exhibits 1 and 2, in which the latch appears as a rigid bar and a pivoted round handle under said bar extending outwardly transversely from the baffle plate trolley. Appellant's baffle plate and carriage unit does not need a latch to hold it in any position on the rods, because it will remain in any position with potatoes traveling on the belt without any latch mechanism [Tr. pp. 56-57 and 71].

Inasmuch as appellant's device requires no latch to hold it in any operative position, but appellees' device is constructed so that it requires a latch to hold it in position, appellee in making his device has done nothing more than to impair the function of appellant's device, *but impairment of function does not avoid infringement.*

> "Infringement is not avoided by the impairment of the functions of an element of a patented device."
>
> Walker on Patents, 6th Ed., Sec. 44, p. 504.

"The fact that an infringer copies imperfectly and does not achieve the full result of the patent is not sufficient to prevent infringement where there has been substantial copying."

Weiss v. Hoe & Co., Inc., 109 F. 2d 722, C. C. A. 2 (1940), c. a. 310 U. S. 639, 84 L. Ed. 1407 (1940);

Amdur, Patent Law and Practice, Infringement, Sec. 14, pages 627 and 628;

Ellett v. Klein (D. C. Pa. 1927), 22 F. 2d 807;

Gen. Electric Co. v. Sundh Electric Co., 198 F. R. 116.

Moreover, defendants-appellees in placing a latch on their device have only *added an element* to appellant's novel *combination* of elements, as covered by Claim 1 of appellant's patent in suit No. 2,288,159, which *latch element is not included in said claim,* because appellant's baffle plate and carriage unit will hold itself in position without a latch [Tr. pp. 56-57 and 71], and consequently the latch is not needed. *Adding* an element to a patented *combination* of elements, covered by a patent claim does not avoid infringement of the claim of the patent.

"*Addition* to a patented machine or manufacture does not enable him who makes, uses, or sells the patented thing with the addition, to avoid a charge of infringement.

* * * * * * * *

This is true even where the *added device facilitates the working* of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence and greater speed."

Walker on Patents (Deller's Ed.), Vol. Three, Sec. 460, pages 1693-1694.

"If an infringing device performs the same function as a patented device, it is *immaterial that it also performs some other function.* It is still, none the less an *equivalent of the patented device, and an appropriation of the patented invention.*"

Chesapeake & O. Ry. Co. v. Kaltenbach, 95 F. 2d 801, C. C. A. 9 (1938).

"Where defendant in an infringement suit uses the principle and appropriates the substance of the claim in issue, the fact that it avoids the letter of the claim by the *addition of an unnecessary element* does not prevent infringement."

B. B. Chemical Co. v. Ellis, 117 F. 2d 829, C. C. A. 1 (1941), aff'd 314 U. S. 495, 86 L. Ed. 367 (1942).

ISSUE 2.

There are glaring misstatements of fact and law in the lower court's decision [Tr. p. 17], whereby said court reached its incorrect conclusions as to the scope of Claim 1 of the patent in suit No. 2,288,159 and as to the question of infringement of said claim by the defendants'-appellees'. Said court overlooked entirely the fact that before the appearance of the appellant's invention covered by said patent there was no baffle plate or shearer 52 in the art or industry movable *longitudinally* over a powered belt conveyor for *automatically* diverting pototoes from the belt over its *side edge* directly and successively into a considerable number of bags supported side-by-side below said belt edge, as said baffle plate 52 is moved by the operator from one bag to another after each bag is filled with potatoes. The most advanced potato-sacking device in the industry was the slow device Plaintiff's Exhibit 7

[Tr. p. 53], which could carry only *two* bags at a time, and said bags were filled one at a time with potatoes delivered from one *end* of a belt conveyor, and *not over a side edge* of the belt as in appellant's invention, patent No. 2,288,159. Said device [Plaintiff's Exhibit 7], was limited to the handling of only *two* bags or sacks on the machine at a time, which limitation was determined by the *width* of the belt because the shiftable platform, on which the sacks were supported, extended *transversely* of the *belt* at one end thereof. The *maximum capacity* of said device was the sacking of *150 sacks per hour.* Said device required considerable *hand labor to shift the heavy platform,* on which the *two* sacks were supported, each time a sack was filled with potatoes, to remove said filled sack from the platform and to bring the other sack into position to be filled with potatoes, while replacing another empty sack on the platform for the removed filled sack. Appellant's machine, patent No. 2,288,159, instead of *two* sacks will carry *seven or more sacks* at a time on the shelf 51, because said shelf extends *longitudinally* of the belt conveyor, and not transversely of the belt, as in the device Plaintiffs' Exhibit 7, and the length of the shelf in appellant's machine and the number of the sacks carried on said shelf is determined by the *length,* and *not the width,* of the conveyor. Appellant's shelf 51 on which the sacks are supported is *stationary* and consequently the *labor of shifting the sack-supporting platform of Plaintiff's Exhibit 7 is eliminated.* The only labor required in appellant's machine to fill one sack after another is the easy movement of the baffle plate 52 from each filled sack to the next empty sack, said baffle plate may be moved *very freely* on the rods 56 and 57, some of which rods are *greased* [Tr. p. 57]. Appellant's machine as covered by

his patent No. 2,288,159 *reduced labor* and *doubled the capacity* of the fastest sacking machine in the industry at the time [Plaintiff's Exhibit 7], to *300 sacks per hour* [Tr. pp. 53, 87 ad 90]. The enlarged capacity of this machine was most extraordinary, and since the machine incorporated a *new principle* and *new mode of operation,* and met with unusual *commercial success,* it truly *marked a most substantial advance in the art,* and the patent No. 2,288,159 covering said machine is entitled to a *liberal construction,* instead of the narrow construction given it by the trial Judge, without a shadow of justification, and contrary to the facts and the law of the case.

The ruling of this Honorable Court in *The Portland Telegram v. New England Fiber Blanket Co.,* 38 F. 2d 780 (C. C. A. 9, 1930), is controlling of the case at bar, regardless of whether the appellant's patent is a primary or a secondary patent. Said ruling is stated in Walker on Patents (Deller's Ed), Vol. 2, Sec. 247, page 1212, as follows:

> "Where an invention undoubtedly marks a substantial advance in the art, the patent is to be given a reasonably liberal construction so as to secure to inventors the reward to which they are entitled."

See, also:

Pointer v. Six Wheel Corporation, 177 F. 2d 153 (C. C. A. 9).

The foregoing case, decided by this Honorable Court, is on all fours with the case at bar, and it is difficult to understand how the same Judge who wrote the decision in said case failed to write a like decision when he tried this case. Evidently the decision in the above *Six Wheel*

case is primarily the decision of the Appellate Judges who heard the case.

In the case of *Eibel Process Company v. Minnesota and Ontario Paper Co.* (1923), 261 U. S. 45, 63, 43 S. Ct. 279, 79 L. Ed., Chief Justice Taft said:

> "In administering the patent law the court first looks into the art, to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent, to secure to the inventor the reward he reserves."

The District Judge in his decision [Tr. pp. 19-20] makes a grossly erroneous comparison of the elements of Claim 1 of each of the patents in suit with the corresponding elements of the appellees' accused and infringing machines, in which the Defendants' Answers to Plaintiffs' Interrogatories and other controlling evidence are entirely overlooked.

Referring to Patent No. 2,288,159 the District Judge erroneously compares the elements of Claim 1 of said patent with the defendants' accused devices and machines, as follows:

> *"Ernsts' analysis shows that Element 1 (a pair of spaced bars longitudinally of the belt) is not present."*

The pair of spaced bars certainly *are* present in the defendants' machines because they are shown in Plaintiff's Interrogatory Exhibits 1 and 2 and are admitted in Defendants' Answers to said Interrogatories II, VII and IX. One of Interrogatory Exhibits 3 and other exhibits show one rod and a plate, and Defendants' Exhibit

D shows two angle irons, which perform the same function and are mechanical equivalents of the two rods of Claim 1 of the patent in suit No. 2,288,159.

> *"Element 2 (a loose sleeve on each bar) is not present, unless the wheels and latch take their place. (See Exhibit 11-B.)"*

The *wheels* of the trolley W, Plaintiff's Exhibit 11-B, do indeed take the place, in defendants' machine, of the plaintiff's *loose sleeves,* because defendants' wheels and plaintiff's sleeves both run on rods or other tracks for moving the baffle plate along the conveyor belt. *Defendants' wheels are the mechanical equivalent of plaintiff's sleeves.* Since plaintiff's sleeve carriage does not employ a latch and no latch is included in the patent claim, the defendants' latch is extraneous, and an *additional element* which does not enable defendants' trolley carriage to avoid infringement of plaintiff's Claim 1 of his patent No. 2,288,159.

> *"Element 3 (a plate having a portion of its ends in the coupling means) is not present."*

The coupling means for the baffle plate in plaintiff's machine are the small brackets (not numbered) formed on the inner side of the sleeves 54 and 55 which slide on the rods 56 and 57, *in* which brackets the ends of the baffle plate are *welded* as stated on page 2, first column, lines 31-33. In the defendants' machine, Plaintiff's Interrogatory Exhibits 1 and 2, the ends of the baffle plate are *bolted to* depending shanks or *brackets* formed on the trolley frames, and this structure is a *coupling means* for the ends of the baffle plate and is the *mechanical equivalent* of the plaintiff's coupling means for the ends of the plate. Whether the ends of the baffle plate are *welded in*

brackets on sleeves, as in plaintiff's machine, or *bolted to brackets on trolley frames,* as in the defendants' machine, is without significance in the patent law, because they are mechanical equivalents and the *same thing.* Such quibbling of the District Court is beneath the notice of this Honorable Court.

Machine Co. v. Murphy, 97 U. S. 120.

"Element 4. The accused device has no coupling means."

The coupling means in the defendants' machines, as pointed out above with reference to Element 3, are shown in Exhibits 1 and 2 of Plaintiff's Interrogatories, and said coupling means are the depending shanks or brackets on the trolley frames to which brackets the ends of the baffle plate are bolted. Defendants' coupling means are also described in Defendants' Answer to Plaintiff's Interrogatory II as follows: "From the framework vertically depends a suspension member (bracket), the lower end of which is *bolted* to the sheer plate. A vertical *slot* is provided in the suspension member, etc."

The remaining misstatements in the lower court's comparison of the elements of the plaintiff's claim and the defendants' machines, to-wit: "The sheer plate takes its place (52)." "The rod and rollers must take their place. (They appear on Fig. 3 to the right of 56)," are nothing but a jumble of words and are meaningless.

Such gross errors of *fact* of the District Judge show clearly that the judge has no understanding of the appellant's invention and said statements are certainly *contrary to the evidence,* and are sufficient alone to justify reversal of the lower court's decision of no infringement

of Claim 1 of the patent No. 2,288,159 by the defendants-appellee.

Defendants'-appellees', while they set up fourteen prior patents in their answer [Tr. p. 7] against appellant's patent in suit No. 2,288,157, they limited the number of said prior patents at the trial to *two,* namely Cunningham No. 873,991, and Hellenbolt No. 1,338,729; the others they are not advancing. [Tr. p. 103.]

Said Cunningham patent and said Hellenbolt patent were both cited by the Patent Office in the application for the patent in suit No. 2,288,159, but they were cited against other claims, and *not against Claim 1* of said patent, *which is the claim sued on herein.* Claim 1 of said patent was filed as Claim 11 on or about February 3, 1942, and was *allowed as filed without the citation of any prior art against it, and it is therefore entitled to a broad construction.* It is also significant that while appellees' counsel had a search made for closer prior art than the Cunningham patent and the Hellenbolt patent no such prior art was found.

The Cunningham patent is a complicated machine having a carriage on which is *pivotally mounted a scraper blade 47, which has to be swung on its pivot out of the way of the straight rollers 36 and 37 under a belt 64, to permit said rollers and belt to be raised* on the carriage by an *elevating mechanism so that said rollers may be moved over and past the cone rollers 7 and 8,* in order to bring the flat part of said belt and said straight rollers, and also the scraper blade 47 from one delivery position or station to another. Such a complicated mechanism and operation for moving appellant's baffle plate 52 in a potato sacking machine from one sack to another would be entirely too slow and impractical, and without utility. [Tr.

pp. 168-170.] Potatoes could be sacked by hand faster than with said Cunningham machine.

The Hellenbolt patent No. 1,338,729 shows a *sorting* apparatus with a block deflector 28 slidably mounted at *one* side only by eyes 29 slidable along a *single* wire 30 over a belt conveyor 3, and said *block 28 rests upon and drags on the moving belt,* because it is not supported at one side and swings down at said side. An operator at the *rear* of the apparatus turns cranks to wind a rope 33 over pulleys to move the deflector 28 to different positions along the belt 3 to deflect apples or like fruit onto one of the screens 13, 14 or 15, where *another operator at the front* of the apparatus removes the culls and drops them into funnels 20. *The apples* or other fruit after rolling down the table over the screens 13, 14 and 15, *are halted by a padded rail 18 at the front of the apparatus, where the operator picks out the fruit from the screens and packs the same by hand in the barrels 19. The rail 18 prevents the apples, etc., from rolling into the barrels 19,* so that the fruit has to be picked out from the table or screens by the operator and *dropped by him* and *not delivered by the deflector 28* into the barrels. *This is a different mode of operation from appellant's machine in* which *the baffle plate 52 diverts and delivers the potatoes from the conveyor belt directly into the sacks without the labor of an operator,* as required in the Hellenbolt apparatus. *Hellenbolt's apparatus could not be used for sacking potatoes automatically by diverting the potatoes from the conveyor belt directly into the sacks,* because the rail 18 of Hellenbolt's machine halts the fruit rolling down the screens 13 to 15 inclusive and prevents the fruit from rolling off said screens, which requires the operator at the front of the apparatus to pick the fruit off the screens and pack the fruit in the barrels 19. In the appellant's machine

the *operator at the front of the machine operates the baffle plate 52* by moving said plate from sack-to-sack for diverting the potatoes from the conveyor belt into the sacks in front of the conveyor for filling said sacks successively. The operator at the *rear of Hellenbolt's machine* for operating the deflector 28 *is eliminated by appellant's machine.* The *operator at the front of Hellenbolt's* machine could not operate the deflector at the *rear* of the machine, because the *distance* from the *front* of the machine to the *rear* of the machine, where the deflector is located is *too great for the front operator to reach said deflector.*

The statement in the decision of the lower court to the effect that appellant's patent No. 2,288,159 is in a crowded field and that appellant seeks apparently in good faith, to broaden Claim 1 of each patent in suit by reference to their specifications is without justification and most absurd. It is certainly significant that the Patent Office did not cite any prior art against Claim 1, originally filed as Claim 11, of the patent in suit, No. 2,288,159,—not even the Cunningham patent or the Hellenbolt patent, the only patents relied upon by counsel for appellee to narrow the scope of Claim 1 of said patent. The Patent Office cited no prior art against said Claim 1 of said patent in suit, because there was no prior art to cite against said claim. Claim 1 of patent in suit No. 2,288,159 is therefore entitled to the broadest possible interpretation and to a very liberal range of equivalents which include the appellees' accused devices and machines.

From the questions asked by the lower court concerning plaintiff-appellant's sacking machine, which was before the court, it is obvious that the judge had not read the patents in suit before the trial, and that he had no correct under-

standing of said patents during the trial of the case or afterwards. [Tr. pp. 56-57.]

In the decision of the lower court [Tr. p. 18] it is intimated, contrary to the record, that appellant seeks to broaden the scope of the claims of his patents, on which this suit is brought, by referring to his patent specifications, and the case of *Blanchard v. Pinkerton,* 77 Fed. Supp. 861, is cited. Said case is not in point, for the reason that nowhere in the record of this case has appellant's counsel tried to broaden the patent claims by referring to the specifications of the patents in suit. Appellant's counsel do not have to refer to the patent specifications to determine the scope of the claims of the patents in suit. It is only necessary for appellant to explain in his patent the *best mode* of applying the principle of his invention, according to R. S. 4888 and his *patent automatically covers all modes,* forms and equivalents of his invention.

Western Electric Co. v. La Rue, 139 U. S. 601, 606, 11 S. Ct. 670, 35 L. Ed. 294.

Second Patent.

The second patent in suit No. Re. 22,740 issued to appellant, Earl A. Ernst, April 2, 1946, is for a Sack Jigger, or a device for shaking and jiggling sacks and their contents, so as to settle the contents to the bottom of the sack and compact the same in the sack. Means are provided for supporting the sacks in open position, and means are also provided for continuously jarring or jiggling the sacks while being filled with a product so as to

insure a full sack of the product being sacked. The invention is especially useful in a machine for sacking *potatoes* and other vegetables, and particularly those vegetables and fruits which are generally shipped in long configurated sacks.

An important feature of the invention is the supporting of the sacks with their upper ends open to receive the potatoes or like products and for continuously jiggling the sacks to compact the products therein and to fill the sacks completely with said products.

For shaking and jiggling the sacks and their contents the invention includes a platform which is indicated 22 in the drawing of the patent No. Re. 22,740 and extends along the entire length of the device for supporting the sacks indicated 34 in position with their upper ends open to receive the products to be shaken and jiggled in said sacks. The platform 22, which is often referred to as a *jigger board,* is suspended at its ends and intermediate its ends by pivotally connected hanger straps 23 which are connected at their upper ends to brackets or extension elements 24 on the frame of the device and at their lower ends to said platform so that said platform may be vibrated or jiggled longitudinally to jiggle the sacks and their contents and thereby settle and compact said contents in said sacks. Cleats 28 are secured to the upper side of the platform 22 transversely thereof at suitable intervals, upon which the bottoms of the sacks 12 rest, whereby said sacks are held in position on the platform 22 and prevented from sliding thereon, said cleats providing a plurality of sack or container stations extending from the ends of

said platform to a central open locus defined by the central frame unit 1 of the device, in which frame unit is mounted a vibratory mechanism driven by a motor 67 and including a push and pull rod unit or jigger 58 for jiggering the jigger board or platform 22, said jigger unit including a plate 57 and a bar 59 connected thereto, forming a *pitman* which is coupled at one end, by coupling means, such as the bracket 60, to a portion of the platform 22, and is attached at its other end to rotary means, such as the crank end 56 of the shaft 53 of said vibratory mechanism, for reciprocating said platform 22 with the sacks supported thereon, and thereby jiggering, and settling and compacting the potatoes or other commodities delivered into the sacks 34 from the side of the conveyor belt 46 by the baffle plate or shearer 72.

Claim 1 of appellant's second patent in suit, No. Re. 22,740, April 2, 1946, Sack Jigger, which claim is the one sued on, is as follows:

> "1. In a device for shaking containers and the like to settle the contents thereof, a framework, a platform for supporting a plurality of containers, hinged means supporting the platform from the framework, vibratory means connected to the platform for shaking it and the containers supported thereby, said means including a pitman adjacent the platform, coupling means connecting the pitman with a portion of the platform, and rotary means attached to the pitman for reciprocating it, said platform including an elongated surface with container stations from the ends thereof to a central open locus, said vibratory means having its connection with the platform at this central locus."

The elements of the invention covered by said Claim 1 are the platform 22 for supporting a plurality of sacks 34; hinged means 23 supporting said platform from the framework, such as the frame posts 4 and 5, 6 and 7, 8 and 9, and 10 and 11; vibratory means connected to the platform for shaking the platform and the containers or bags 34 supported thereon, which vibratory means comprises a pitman 57-59; coupling means 60 connecting said pitman with the platform 22, and rotary means such as eccentric or crank 56, attached to said pitman for reciprocating it, said rotary means being driven by motor 67 through pulleys and belts; and said platform 22 including an elongated surface, such as the surface of a board, known as a jigger board, with container or sack stations, such as transverse cleats 28, spaced from the ends of the platform to a central open locus, or central frame unit 1.

The invention covered by Claim 1 of the patent in suit No. 2,288,159, for Sacking Device, and the invention covered by Claim 1 of the patent in suit, No. Re. 22,740, for Sack Jigger, are adapted to cooperate with each other and are combined in one machine, as shown in Fig. 1 and Fig. 2 of the second patent in suit, No. Re. 22,740, and as shown in appellant's machine in Plaintiff's Exhibits 8, 9 and 10, and as combined in appellee's machines, Plaintiff's Exhibit 5, Plaintiff's Interrogatories, Exhibit 3-3; Plaintiff's Exhibits 11-A, and Defendants' Exhibits A, B, C. D and E. The two inventions of the patents in suit, when combined in one machine, as aforesaid, are driven by one motor 67 through sprockets and chains as shown in Fig. 1 and Fig. 2 of patent No. Re. 22,740 in suit, and in Defendants' Exhibit E.

INFRINGEMENT OF CLAIM 1.

Patent No. Re. 22,740.

Issue 3.

Infringement of Claim 1 of Patent No. Re. 22,740 in suit is clearly shown in Plaintiff's Interrogatories, and Defendants' Answers to Plaintiff's Interrogatories, Plaintiff's Exhibits 5 and 6, respectively, including Interrogatory Exhibits 3-3, Plaintiff's Exhibits 11-A, 11-C, 12-A, and 12-B, and Defendants' Exhibits A, B, C, D and E.

Interrogatory Exhibits 3-3 of Plaintiff's Interogatories, Plaintiff's Exhibit 5, and Defendants' Answers to Plaintiff's Interrogatories IV, VI and XI, Plaintiff's Exhibit 6, prove that since the issuance of the Ernst Patent in suit, No. Re. 22,740, April 2, 1946, defendants'-appellees' have made, used and/or sold a Sack Jigger containing all of the elements of the novel combination of elements included in Claim 1 of said patent No. Re. 22,740, and consequently defendants-appellees have infringed said claim of said patent.

Defendants' Answer to Plaintiff's Interrogatory IV admits that defendants have manufactured and sold two forms of infringing apparatus prior to the filing of this suit, to-wit: Form 1 and Form 2. Defendants' description of Form 1 in answer to Interrogatory IV corresponds to defendants' machine shown in Plaintiff's Interrogatory Exhibits 3-3, which defendants have admitted in answer to Plaintiff's Interrogatory XI. In the defendants' machines shown in said Exhibits 3-3 the divided plank or platform corresponding to appellant's *single* platform 22 is cut between its ends and divided into two platform *sections,* each of which sections is connected at its inner end to one end of a strap or *pitman,* the other

end of which pitman is connected to an *eccentric* or *crank,* which, when rotated *reciprocates* said pitmans and said *platform sections, with potato sacks supported thereon,* to jigger the potatoes to settle and compact the same in said sacks, which potatoes are diverted from the belt conveyor 46 by the baffle plate 72 into said sacks, as said platform or jigger board is reciprocated as illustrated in Figs. 1 and 2, of patent in suit No. Re. 22,740, Plaintiff's Exhibit No. 2. Defendants' machine, Exhibits 3-3 of Plaintiff's Interrogatories No. 5, contains identically the *same combination of elements* as Claim 1 of appellant's patent in suit No. Re. 22,740, and, when considered in terms of the patent law, defendants' machine, as shown in said Interrogatory Exhibit 3-3, is a Chinese copy of appellant's invention as covered by said Claim 1 of said patent, and is a clear and unmitigated *infringement* of said claim.

Reading Claim 1 of appellant's patent in suit, No. Re. 22,740 verbatim, element by element, on the defendants'-appellees' machine, as shown in Plaintiff's Interrogatory Exhibit No. 3-3, said machine contains the complete novel *combination* of elements of appellant's said claim, as follows:

1. A framework.

2. A platform.

3. Hinge means supporting the platform from the framework.

4. Vibratory means connected to the platform for shaking it, and the containers (potato sacks) supported thereby.

5. Said (vibratory) means including a pitman adjacent the platform.

6. Coupling means connecting the pitman with a portion of the platform.

7. And rotary means attached to the pitman for reciprocating it.

8. Said platform including an elongated surface with container stations from the ends thereof to a central open locus.

9. Said vibratory means having its connection with the platform at this central locus.

Referring to Element 1, "a framework" in the above table of elements of Claim 1 of appellant's patent in suit, No. Re. 22,740, one glance at Plaintiff's Interrogatory, Exhibits 3-3, defendants' machine, will show that said machine of defendants has said Element 1, to-wit: a framework.

Referring particularly to element 2, "a platform," in defendants'-appellees' machine, Interrogatory Exhibit 3-3, the cutting of the platform or jigger board in half and forming *two platform sections* instead of *one continuous platform* 22, as disclosed in the patent in suit No. Re. 22,740, amounts to nothing but making an element in *two* pieces instead of *one,* as disclosed in a patent. Such a slight change in structure, when the *two pieces perform the same function,* in *substantially the same way, and accomplish the same result,* as *one* piece, does not avoid a charge of infringement of a patent which discloses and claims the element in *one* piece.

> "Infringement is not avoided by *dividing an integral element* of the patented machine into *two or more distinct parts,* so long as the function and operation remain substantially the same."
>
> *Kings County Raisin & Fruit Co. v. U. S. Consol. S. R. Co.,* 182 Fed. 59 (C. C. A., 9th Cir.).

The following cases appear in Deller's Edition of Walker on Patents, 1948 Cumulative Supplement, pages 1698-1699, Section 462:

> "In suit for infringement of a fan, it is no departure from the patent to use a *blank* of blades instead of *single* blades, or a *two-piece* hub instead of a *one-piece* hub to accomplish the same result."
>
> *Samson-United Corp. v. Sears, Roebuck & Co., Inc.,* 103 F. 2d 312 (C. C. A. 8, 1939), cert. den. 307 U. S. 638, 83 L. Ed. 1519 (1939).

> "In infringement suit, separation in accused device of *one* unit into *two* parts, performing the same function in the same manner as the unit of the infringed structure, does not avoid infringement."
>
> *Ace Patents Corp. v. Exhibit Supply Co.,* 119 F. 2d 349 (C. C. A. 7, 1941), mod. 315 U. S. 126, 86 L. Ed. 736 (1942).

> "Infringement cannot be avoided when *split* covers are used by infringer instead of *one* cover over a triple compression press where patented claims did not contain any limitation as to the form of cover."
>
> *Galland-Henning Mfg. Co. v. Logemann Bros. Co.,* 142 F. 2d 700 (C. C. A. 7, 1944).

Element 3 of Claim 1 of appellant's Patent No. Re. 22,740, to wit: "Hinge means supporting the platform from the framework," are located on appellees' machine, Interrogatory Exhibit 3-3, at the ends, respectively, of each of the two sections of the divided platform, and are in the form of *links* or *straps pivotally* connected at their upper ends to *brackets* extending forwardly from the framework at the front of the machine, and *pivotally* con-

nected at their lower ends to the ends of the two sections of the platform, so that said sections of the platform may be reciprocated by the crank and straps between the divided ends of said platform sections.

Element 4 of Claim 1 of appellant's Patent No. Re. 22,740, to wit: "Vibratory means connected to the platform for shaking it and the containers (potato sacks) supported thereby," is shown at the *central open locus,* or "open place," between the ends of the defendants' machine, Interrogatory Exhibit 3-3, and comprises an electric motor, as shown in Defendants' Exhibit E and described in Defendants' Answer to Plaintiff's Interrogatory IV, Form 1; an eccentric or crank at the center and lower part of said central open locus, which eccentric or crank is driven by said electric motor through sprockets and a *chain* [see also Plaintiff's Exhibit 11-B] extending from said motor over an eccentric or crank sprocket and shown in the lower left part of said central open locus, and the straps or *pitmen* connected at one end to said eccentric or crank, and at their other ends to the inner ends of the sections of the divided platform.

Element 5, "Said (vibratory) means including a *pitman* adjacent the platform," finds its analogue in the so-called *connecting straps* described in Defendants' Answer to Plaintiff's Interrogatory IV, Form 1, and shown in Plaintiff's Interrogatory Exhibits 3-3, which connecting *straps connect* the defendants' eccentric or crank and the *inner ends of the sections of the defendants' platform,* and transmit reciprocating motion from said eccentric or crank to the platform sections on which the potato sacks are supported, for jiggling the potatoes and settling and compacting the same in said sacks. Appellees' *connecting straps* are the mechanical *equivalent* of plaintiff's *pitman*

designated 57 and 59 of appellant's push and pull rod unit or jigger 58, shown in Figs. 1 and 2 of appellant's patent in suit No. Re. 22,740.

Element 6, "coupling means connecting the pitman with a portion of the platform" are found in the defendants' machine, Plaintiff's Interrogatory Exhibits 3-3 and Defendants' Answer to Plaintiff's Interrogatory IV, Form 1, which answer states: "an eccentric which is coupled with a *connecting strap* (pitman), the opposite end of which is *attached* to the rear end of the plank" (platform section). The *coupling means* connecting the pitman (straps) in appellees' machine with a portion of the platform, are the means whereby said opposite end of the strap is *attached* to the rear end of the plank (platform) and comprises *a pair of spaced ears* or *bearings secured to the rear end of each platform or plank section between each pair of which ears the said opposite end of one of the two connecting straps is pivoted by a pivot pin to said ears.* This *pivot connection or coupling* of the *connecting straps to the rear or inner ends of the platform sections in defendants' machine is the mechanical equivalent of the appellant's coupling means comprising the pivot connection 61 between the bracket 60 and pitman 57 and 59, which bracket is secured to a portion of the platform 22,* as claimed in Claim 1 of appellant's patent No. Re. 22,740.

Element 7, "And rotary means attached to the pitman for reciprocating it" is found in the rotary "eccentric" or crank in the lower central part of the central open locus, to which eccentric or crank one end of each connecting strap is *attached* or pivotally connected in appellees' machine, Plaintiff's Interrogatory Exhibits 3-3. The attachment of the rotary means to the pitman in appellees' machine is *identical* to the attachment of appellant's

rotary means or crank end 56 to the plate 57 of his pitman 57-59, as shown, described and claimed in plaintiff's patent No. Re. 22,740.

Element 8, "Said platform including an elongated surface with container stations from the ends thereof to a central open locus," comprises the cleats 28 secured to the upper surface of the platform 22 as claimed in Claim 1 of appellant's patent No. Re. 22,740, which cleats are clearly shown on the platform of one of Plaintiff's Interrogatory Exhibits 3, in Plaintiff's Exhibits 12-A and 12-B, and in Defendants' Exhibits A, B, C and D. *Said cleats 28 forming sack stations spaced along the platform 22 from the ends thereof to the central open locus,* are an important feature of appellant's invention of which there is no suggestion in the prior art set up in the defendants' answer; and it is significant that there are no such cleats in the machine, Plaintiff's Exhibit 7, which was the most efficient potato sacking machine in the industry prior to appellant's sacking machine patents.

Element 9, "Said vibratory means having its connection with the platform at this central locus" is not an element, but merely part of the explanation of the "best mode" or form of his invention which appellant contemplated in applying the principle of his invention, when he filed his application for patent in the Patent Office, according to R. S. Section 4888 (U. S. C., Title 35, Sec. 33). Appellant is not limited to this mode or form of his invention of having the connection of the vibratory means to the platform at the central open locus, because the description of the invention in its *best mode or form* in a patent secures protection of the invention in every form in which it may be copied, unless the patentee manifests an inten-

tion to disclaim some of those forms, which the appellant has not done with his patents in suit.

> *Western Electric Co. v. La Rue,* 139 U. S. 601, 606, 11 S. Ct. 670, 35 L. Ed. 294.

However, defendants in their machine, as shown in Plaintiff's Interrogatory Exhibit 3-3, have copied Element 9 of Claim 1 of the patent in suit, No. Re. 22,740, by connecting the vibratory means (connecting straps or pitman) to the inner ends of the platform sections, at the *central open locus* of defendants' said machine, so that Claim 1 of said patent reads letter perfect on said defendants' machine, as shown in said Interrogatory Exhibit 3-3.

From the foregoing comparison of defendants' machine, as shown in Plaintiff's Interrogatory Exhibits 3-3, with Claim 1 of the patent in suit, No. Re. 22,740, and the reading of said claim literally on said defendants' machine, a complete and perfect case of infringement of said claim of said patent by defendants is proven beyond a shadow of a doubt. Yet the Trial Judge in this case completely overlooked or ignored this glaring infringement, *contrary to the evidence,* by the defendants-appellees of the plaintiff-appellant's *meritorious* patent, No. Re. 22,740, which has *revolutionized* the potato sacking industry by presenting an automatic machine to the industry that has increased the sacking of potatoes from 150 sacks per hour to from 500 to 600 sacks per hour, to meet the demand of our California and other potato farmers.

A more perfect case of wilful and wanton infringement of a patent, than the infringement by the defendants-appellees of Claim 1 of plaintiff-appellant's patent No. Re. 22,740, would be difficult to find in the annals of the patent law.

Defendants in their Answer to Plaintiff's Interrogatory IV, Form 2, admit manufacturing and selling a machine identical with Plaintiff's Interrogatory Exhibits 3-3, "except that the inner ends of the two planks or platforms which remain separated as before are fixedly interconnected by a rigid strap or bar. The motor and eccentric mechanism are located at one extreme end of the aligned platforms instead of between them and a single connecting strap communicates reciprocatory motion from the eccentric to the adjacent platform end."

The above described Form 2 in defendants' Answer to Plaintiff's Interrogatory IV is shown in Plaintiff's Exhibits 11-A and 12-A, and Defendants' Exhibits A, B, C, D and E. The interconnecting rigid strap or *bar* described in said Form 2 is shown in Plaintiff's Exhibits 11-A and 12-A, and in Defendants' Exhibit A.

The connection of the inner ends of the two planks by a rigid strap or bar amounts to nothing more than making the platform in *two pieces connected together,* or connected by a *third piece,* instead of making the platform in one piece. Such immaterial *changes of form* do not avoid infringement of Claim 1 of appellant's patent No. Re. 22,740.

> "Infringement is not avoided by using *two pieces* of paper instead of one *and gluing them together.*"
>
> *Southerland Paper Co. v. Auburn Carton Corp.,* 118 F. 2d (C. C. A. 7, 1941);
>
> *The Portland Telegram v. New England Fiber Blanket Co.,* 38 F. 2d 780 (C. C. A. 9).

"Infringement is not avoided by *dividing an integral element* of the patented machine *into two or more distinct parts,* so long as the function and operation remain substantially the same."

Kings County Raisin & Fruit Co. v. U. S. Consol. S. R. Co., 182 Fed. 59 (C. C. A. 9th Cir);

Samson-United Corp. v. Sears, Roebuck & Co., Inc., 103 F. 2d 312 (C. C. A. 2), c. d. 307 U. S. 638, 83 L. Ed. 1519.

"Change of *form* without change of function does not avoid infringement."

Triangle Kapok Mac. Corp. v. Salinger Bedding Co., 13 F. 2d 494;

E. H. Bardes Range & Foundry Co. v. American Engineering Co., 109 F. 2d 696 (C. C. A. 6);

Mathews v. Koolvent Metal Awning Co., 158 F. 2d 37 (C. C. A. 5, 1946);

Machine Co. v. Murphy, 97 U. S. 120.

Form 2 of defendants-appellees' machine, in which the vibrating means for the platform is connected to *one end* of the platform, instead of *intermediate the ends* of the platform *at the central open locus* of the machine, as stated in Claim 1 of appellees' patent, No. Re. 22,740, does not avoid infringement of said claim, because such a change is merely a *change of form,* or *change of location,* or *transposition of parts.*

Connection of the vibrating means at one end of the platform of defendants-appellees' machine is shown in Plaintiff's Exhibits 11-C, 12-A and 13, and in Defendants' Exhibits A, B, C, D and E.

The connection of the vibratory means intermediate the ends of the platform, at the central open locus of the machine, as stated in Claim 1 of appellant's patent in suit, No. Re. 22,740, was considered by the appellant to be the best mode or form of his invention at the time he filed his application for patent, and having described the "best mode" of his invention in his patent (R. S. Sec. 4888), appellant's said patent covers *all forms* of his invention, which include Form 2 of defendants'-appellees' machines which have the *vibratory means connected to one end* of the platform or jigger board 22, as shown in Plaintiff's Exhibits 11-C, 12-A and 13, and Defendants' Exhibits A, B. C, D and E.

> "The patentee having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is in contemplation of law, deemed to *claim every form* in which his invention may be copied, unless he manifests an intention to disclaim some of those other forms."
>
> *Western Electric Co. v. La Rue,* 139 U. S. 601, 606, 11 S. Ct. 670, 35 L. Ed. 294.

The *change of location or relocation* of the vibratory means from the intermediate portion of the platform or jigger board, to the end of the jigger board in certain of the defendants' machines.

> Walker on Patents (Deller's Ed.), Vol. 3, Sec. 479, p. 1723.

> "This *relocation* is such as any electrical engineer would readily conceive, and is not an inventive difference from Howe, but is within the equivalents to which his patent is entitled."
>
> *General Ry. Signal Co. v. Great Northern Ry. Co.,* 43 F. 2d 790, 806 (C. C. A. 8).

The placing of the vibratory means on the *end* of the platform or jigger board in defendants' machine, instead of intermediate the ends of the platform as in the patent in suit, amounts to nothing more than *transposition of parts,* which does not avoid infringement of a patent, where the parts transposed perform the same respective functions after the change as before, as in the defendants'-appellees' machines.

> *Bianchi v. Barili,* 184 F. 2d 793 (C. C. A. 9th Cir.).

In the foregoing case this Honorable Court also held:

> "To constitute 'infringement' it is unnecessaary to demonstrate substantial identity between machines to a mathematical certainty, but 'infringement' connotes correspondence as to the substantial dominant and essential elements."

The idea of connecting the vibratory means to *the end* of the jigger board is not new or original with defendants-appellees, but is stated to be within the scope of appellant's patent in suit, No. Re. 22,740, on page 1, first column, lines 48-55, as follows:

> "The sacking device in the particular form illustrated comprises a central portion 1 and elongated side portions or extensions 2 and 3. These side portions may be identical in construction and are identical in this form of the invention, but need not necessarily be identical. *One of the side portions may be omitted entirely."*

When one of the side portions 2 or 3 of the appellant's patented machine is omitted, for example the side portion 2 at the left of the machine, a small machine with three

sack stations is produced like defendants' machine called a "one man jigger," Plaintiff's Exhibit 12-B, which has its *vibratory means located at the left end of the machine,* with the pitman of said vibratory means extended to the right and *connected to the platform near the right end thereof.* This machine of defendants-appellees, Plaintiff's Exhibit 12-B, is a mechanical equivalent of appellant's invention, as claimed in Claim 1 of appellant's patent, No. Re. 22,740, and as interpreted in the light of the statement quoted above from the specification of said patent, on page 1, first column, lines 48-55, and consequently appellees' machine, Plaintiff's Exhibit 12-B, is an infringement of Claim 1 of appellant's said patent No. Re. 22,740.

ISSUE 4.

In the decision of the lower court the District Judge makes the most extraordinary misstatements of fact and law in his so-called analysis of the question of defendants' infringement of the plaintiff's Patent No. Re. 22,740 [Tr. p. 20]. Instead of considering the admissions of the defendants in their Answers to Plaintiff's Interrogatories and the Interrogatory Exhibits 3-3, to which the defendants' admissions applied, the District Judge directs his analysis to defendants' crude and clumsy machine, as shown in Plaintiff's Exhibit 11c, which is the same machine as shown in a blueprint, Plaintiff's Exhibit 13.

In said analysis of the District Judge three elements are considered, contrary to the law and the facts of the case.

Element 1: Instead of a pitman adjacent the platform we find a cross bar [Exhibit 11c]. This machine, Plaintiff's Exhibit 11c, certainly has a pitman, which is the long channel bar extending from the central open locus

of the machine to the left end of the machine and is spaced *horizontally* from the platform or jigger board, about the same distance that the appellant's pitman is spaced *vertically* above the platform of his machine, as shown in Plaintiff's Exhibits 8, 9 and 10. It will be noted that said Exhibit 11c is on a larger scale than Exhibits 8, 9 and 10. The so-called cross bar at the left end of the defendants' machine, Plaintiff's Exhibit 11c, is not used *instead* of the pitman above described, but is connected midway between its ends to the near end of said pitman. Said so-called cross bar, which is actually a lever of the third class, serves the same purpose as the bracket 60 in appellant's patent in suit, No. Re. 22,740, and the bracket shown in Plaintiff's Exhibits 8, 9 and 10, which *connects* the end of the pitman to the platform and transmits the reciprocating movement of the pitman to the platform to jigger the potatoes in the sacks on said platform. The District Judge overlooks the term "coupling means connecting the pitman with a portion of the platform," which term is certainly broad enough to include the defendants'-appellees' so-called cross bar and plaintiff's-appellant's bracket 60, since the word "means" is the broadest term in the patent law.

Element 2: Instead of a central open locus, the accused device shows a board, not at center [Exhibit 11-A]. This statement is not correct. Exhibit 11-A certainly shows a central open locus in the upright frame of the machine where the sprockets and chains of the vibrating mechanism appear. The board referred to is the *bar,* which is narrower than the platform and connects the inner ends of the divided sections of the platform. Said board or bar has nothing to do with the open locus (open place) in the *frame* of the machine, even though said board or bar is

located directly in front and at the lower part of said open locus.

Element 3: A rigid connection takes the place of one long board. (The jigger connection is at the end of the machine.) The rigid connection referred to is evidently the intermediate bar shown in Exhibit 11-A, which connects the inner ends of the two sections of a divided platform. This form of appellees' platform is made in three sections, to wit: the two divided end sections and the intermediate connecting bar section. Infringement is not avoided by appellees by making their platform in three pieces instead of one, and the claim of appellant's patent is not limited anyway to *one* long board forming the platform. Authorities holding that infringement is not avoided by making an element in *two or more pieces* instead of *one,* have heretofore been cited herein. The jigger connection at the *end* of the defendant's machine, instead of intermediate the ends of the machine, is only a change of form, or relocation, or transposition of a part, which does not avoid infringement of the patent in suit, and authorities so holding have already been cited herein.

The statement in the lower court's decision [Tr. p. 20] that "Ernst combines two platforms (elements (1) and (3)) in order to arrive at one effect (element 2)," is a *reductio ad absurdum.* Ernst has never combined two platforms in order to arrive at one effect, or one platform. Ernst has always made his platform from *one board* and he made the same before the appellees came into the field and infringed his patents. The shoe is on the other foot. The appellees conceived the bright idea of cutting a board and making their platform in two pieces of the cut board, in order to avoid infringement of the appellant's patents, but that idea was not so bright, because their multiple

piece platform has the opposite effect of infringing the appellant's patent.

Another fantastic statement appearing in the lower court's decision is that "the claims of Ernst's patent, as he reads them are almost identical with the British Patent No. 397679 (Belcher) * * * and in that event, both he and the defendants are infringing the British patent." In the first place the British patent has a different operation from that of appellant's patent, in that the containers in the British patent are *pushed over* a platform or plate 11, which is given an *up and down vertical movement* at its center only, while the sacks in appellees' machine are *not pushed over the jigger board but are held in one position only* on the jigger board by cleats 28 and the jigger board is not given a vertical movement but is *reciprocated horizontally.* As for the parties to this suit infringing the Belcher patent, whoever heard of anyone infringing a British patent in the United States?

In the defendants' answer, Paragraph XIII, twenty prior "paper" patents are set up to invalidate or narrow the scope of appellees' patent No. Re. 22,740, but defendants' counsel at the trial limited said prior patents to three, and introduced the remaining seventeen patents in evidence for window dressing in order to contend, without support of a patent expert, as to said remaining patents, that the plaintiff's patent is in a crowded art and is thereby limited in scope [Tr. p. 103]. This defense is a "phoney" since there is no evidence that any one of said prior patents was ever built and operated, and there is nothing in any of said patents to show that they could be used for sacking *potatoes.*

Pointer v. Six Wheel Corporation, 177 F. 2d 153, at p. 161.

The three prior patents selected as best references against appellant's patent in suit, No. Re. 22,740, were Bradbury No. 826,988 and Naeher, No. 1,719,124, which is not a file wrapper reference, and neither is Bradbury, and the third is Erickson, No. 2,043,739 [Tr. p. 103].

The Bradbury patent No. 826,988 is a *grain separator* for the separation of the grain and valuable matter from the straw, chaff and lighter particles. There is nothing in this patent to show that it could be used for sacking *potatoes.* The Bradbury patent is in a *different art* from that of appellant's invention. In the Bradbury patent, Fig. 1 is shown a shaking shoe S, which is reciprocated longitudinally by a crank 101 and pitman 100. The shoe S is *inclined* downwardly from its receiving upper end, into which end grain is delivered by a spout 75, and as said shoe is reciprocated by said crank the grain flows down said inclined shoe by gravity and drops off the lower end of said shoe into a rotary screen for screening the grain.

Said Bradbury patent operates on an entirely *different principle* from that of appellant's sack jigger. The spout 75 in Bradbury's machine for delivering the grain into the upper end of the shoe S would not be practical in a potato-sacking machine because potatoes choke up a spout and prevent the potatoes from passing through the spout into the sacks for sacking the potatoes. Spouts have been tried and abandoned after failure [Tr. p. 197]. There are no stations on the shoe S like the stations (cleats 28) in appellant's patent, for holding potato sacks on said shoe in position against slipping on said shoe, so

that the sacks may be filled rapidly and in succession from one side of a conveyor belt, as in appellant's machine. If potato sacks were placed on Bradbury's inclined shoe S they would slide out of position down said inclined shoe. The Bradbury patent does show a machine that could operate as a potato sacker like appellant's machine.

In the Naeher patent No. 1,719,124 the platform 12, on which are placed the bags to be filled, has an *up-and-down vertical swinging movement,* and not a *horizontal reciprocating movement* like appellant's jigger board 22. The *reciprocating horizontal movement* of appellant's jigger board is vitally important. A vertical movement like the movement of Naeher's platform 12 would throw off the *special potato sacks* used in a potato sacking machine, and such vertical movement of Naeher's machine would throw the uppermost potatoes up in the sacks, so that they would drop on the potatoes below and bruise the potatoes, and cause them to rot [Tr. p. 58]. The court took judicial notice of the fact that if a platform on which a sack of potatoes is supported, is moved up and down, the potatoes will "jump like a jumping bean" [Tr. p. 163]. The Naeher machine was never intended to sack potatoes and there is no evidence that it was ever used for such purpose. The Naeher patent, page 1, first column, lines 4-6, states that it "is an improvement upon the type of machine disclosed in patent No. 1,616,016," and consequently patent No. 1,616,-016 is made a part of and limits the Naeher patent. Patent No. 1,616,016 was not offered in evidence by the defendants, but was introduced in evidence by plaintiff as Plain-

tiff's Exhibit No. 14. Said patent was issued to Antony Wertenbruch and later reissued to him on April 17, 1928, as Reissue No. 16934. The Naeher patent does not state the kind of materials it handles in filling bags, but the Wertenbruch patent No. 1,616,016 on which the Naeher patent is an improvement, states on page 1, first column, lines 14-29, that it is a machine for filling and compacting *granular material* in bags, into which the granular material is directed by spouts. The Naeher patent, being necessarily interpreted in the light of the Wertenbruch patent No. 1,616,016, is therefore a machine for filling bags with *granular* material with the use of *spouts,* as shown in the Naeher patent and indicated A in the Wertenbruch patent No. 1,616,016. The Naeher patent, therefore, could not be used for sacking potatoes, in view of its *vertical* movement of its platform and the use of *spouts,* which have been proved to be unsuccessful [Tr. p. 197].

The Erickson *et al.,* patent, No. 2,043,739, the last of the three best references set up against the appellant's patent No. Re. 22,740, is a "Method and Apparatus for Proportioning and Mixing Fruit," and is used in the art of canning fruit and the like and for proportioning and mixing *diced* fruits etc. preparatory to canning or other preserving operations. The apparatus has a series of *inclined* shaker tables C, D and E down which the water and fruit flow for draining the fruit of the water. The shaker tables have no stations like appellant's cleats 28 for holding sacks stationary against sliding on said

shaker tables, for filling such sacks with potatoes and compacting the potatoes in said sacks by the shaking movement of said tables. This Erickson patent could not be used for sacking potatoes, and has little or no bearing on appellant's invention.

The three best references as above considered are in arts entirely foreign to the potato sacking art and since they do not disclose the elements of appellant's invention they are without significance, or probative values.

From the foregoing analysis of the case it is submitted that appellant has presented to the potato sacking industry an invention of the first magnitude, which has quadrupled the capacity of the fastest potato-sacking machine in use at the time of his invention, and has revolutionized the potato-sacking industry. Appellant's patent No. Re. 22,740 is accordingly entitled to a very liberal construction and to be read on the defendants'-appellees' accused and infringing machines.

> *Eibel Process Company v. Minnesota and Ontario Paper Co.,* 1923, 261 U. S. 45, 63, 43 S. Ct. 322, 328, 67 L. Ed. 523.

Issue 5.

A clear and unmitigated case of wilful and wanton infringement of Claim 1 of each of the two patents in suit is made out against the defendants-appellees, and each of them, in view of the evidence and the law of the case, as presented herein, and the Final Judgment of no infringement in the case is contrary to the evidence and the law.

Conclusion.

It is submitted that appellant has abundantly made out his case of infringement of Claim 1 of each of the two patents in suit against the defendants-appellees; that the Final Judgment of dismissal of the suit be reversed, and that this Honorable Court render judgment of infringement of Claim 1 of each of the two patents in suit by the defendants-appellees; that an accounting for damages be had against appellees and that said damages be trebbled; and that appellant recover his costs against defendants-appellees.

Respectfully submitted,

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